

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today
(1) was not written for publication in a law journal and
(2) is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte CHARLES LAPINSKI,
CHARLES ECKERT, RICHARD SKOKOWSKI,
JAMES COX, WILLIAM SCOTT,
EDWARD CHALEFF, JEFFREY G. SHARPE
and DAVID A. WURZ

Appeal No. 1997-4461
Application 08/482,893

HEARD: JANUARY 11, 2000

Before JERRY SMITH, FLEMING and FRAHM, Administrative Patent
Judges.

JERRY SMITH, Administrative Patent Judge.

DECISION ON APPEAL

Appeal No. 1997-4461
Application 08/482893

This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's rejection of claims 49-61, which constitute all the claims remaining in the application.

The disclosed invention pertains to a method and apparatus for reconstructing a bar coded symbol based on a plurality of separate scanned fragments of the full symbol.

Representative claim 49 is reproduced as follows:

49. An improved scanner of a type having scanning means for repetitively scanning a code and for providing a scan signal repetitively corresponding to at least a fragment of said code; clock means for generating counts; storage means for repetitively storing said scan signal; and a processor for combining successive scan signals into an extended scan signal cluster; the improvement characterized by:

said scan signal comprising a series of stored counts, each of which corresponds to a transition between code elements; and

said processor further comprising:

means for comparing stored counts from successive scan signals;

means for detecting matching portions of compared counts;

means for combining successive counts having matching portions into the extended scan signal cluster; and

means for decoding said cluster.

The examiner relies on the following reference:

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Yasuda et al. (Yasuda) 4,409,469 Oct. 11, 1983

Claims 49-61 stand rejected under 35 U.S.C. § 103. As evidence of obviousness the examiner offers Yasuda taken alone.

Rather than repeat the arguments of appellants or the examiner, we make reference to the brief and the answer for the respective details thereof.

OPINION

We have carefully considered the subject matter on appeal, the rejection advanced by the examiner and the evidence of obviousness relied upon by the examiner as support for the rejection. We have, likewise, reviewed and taken into consideration, in reaching our decision, the appellants' arguments set forth in the brief along with the examiner's rationale in support of the rejection and arguments in rebuttal set forth in the examiner's answer.

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would not have suggested to one of ordinary skill in the art the obviousness of the invention as set forth in claims 49-61. Accordingly, we reverse.

Appellants have nominally indicated that the claims on appeal should stand or fall in two separate groups [brief, page 3]. Despite this grouping, however, appellants have made no separate arguments with respect to any of the appealed claims. Since appellants have failed to appropriately argue the separate patentability of the claims, all contested claims stand or fall together. See In re King, 801 F.2d 1324, 1325, 231 USPQ 136, 137 (Fed. Cir. 1986); In re Sernaker, 702 F.2d 989, 991, 217 USPQ 1, 3 (Fed. Cir. 1983). Accordingly, we will consider the rejection against independent claim 49 as representative of all the claims on appeal.

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem

from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). If that burden is met, the burden then shifts to the applicant to overcome the prima facie case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See Id.; In re Hedges, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); and In re Rinehart, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976). Only those arguments actually made by appellants have been

considered in this decision. Arguments which appellants could have made but chose not to make in the brief have not been considered [see 37 CFR § 1.192(a)].

With respect to representative, independent claim 49, the examiner essentially asserts that Yasuda teaches the claimed invention except that Yasuda uses digitized count data for comparison rather than utilizing stored counts as the medium for comparison. The examiner argues that it would have been obvious to use stored count data in place of the digitized data of Yasuda [answer, page 4].

Appellants argue that the specific claimed method and apparatus for reconstruction of a bar coded symbol using stored counts is not taught or suggested by Yasuda [brief, pages 7-16]. We agree with appellants.

Although the device of Yasuda can reconstruct a bar coded symbol from a plurality of scanned segments of the symbol, the reconstruction in Yasuda does not use stored counts as claimed nor does Yasuda have each of the means specifically recited in claim 49. The examiner's rejection fails to accord appropriate weight to each of the limitations set forth in the claims.

With respect to the recitation of stored counts in claim 49, the examiner simply asserts that it would have been obvious to use stored counts instead of digitized data. The examiner attempts to buttress this position by citing patents issued to Engstrom and Enser which have not been listed in the statement of the rejection. A reference not positively included in a statement of rejection is not considered. In re Hoch, 428 F.2d 1341, 1342 n.3, 166 USPQ 406, 407 n.3 (CCPA 1970). Therefore, the teachings of Engstrom and Enser are not before us with respect to the propriety of the examiner's rejection.

Of more importance, however, is the fact that Yasuda does not teach a processor having the four means recited in claim 49. Although the examiner attempts to read the language of claim 49 broad enough to read on the Yasuda device, the examiner's interpretation of the claim is untenable. Yasuda reconstructs a bar coded symbol by implementing equation (1) as set forth at the bottom of column 4 of the patent. Equation (1) reconstructs the pattern a (Figure 8) by combining a_1' , a_2' , a_3' and a_4' as independent geometric portions of the pattern a. These portions do not overlap.

Yasuda stores each of these portions in a separate register (50, 52, 54 and 56) for calculation of equation (1). We fail to see how the information stored in Yasuda's registers can be considered to be a comparison of successive scan signals or a detection of matching portions of the compared scans. The Yasuda device does not have overlapping portions so that there is no need to look for matching portions of successive scans in order to reconstruct the bar coded symbol. As noted above, Yasuda achieves the same result as the claimed invention but Yasuda gets there by an entirely different procedure which does not suggest the specific method and means of the claimed invention.

For these reasons, we agree with appellants that the scanner apparatus of claim 49 and the scanner method of claim 56 are neither taught nor suggested by the scanner of Yasuda. Accordingly, the decision of the examiner rejecting claims 49-61 is reversed.

REVERSED

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	JERRY SMITH)	
	Administrative Patent Judge)	
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	MICHAEL R. FLEMING)	BOARD OF
PATENT)	
	Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
)	
)	
	ERIC S. FRAHM)	
	Administrative Patent Judge)	

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Volpe and Koenig
400 One Penn Center
1617 John F. Kennedy Blvd.
Philadelphia, PA 19103